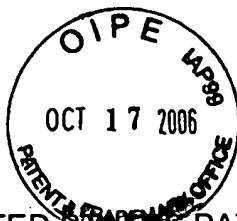


P23561.A12 00063906



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Masami SHIRAI et al.

Group Art Unit: 2872

Appln. No. : 10/619,499

Examiner: Joshua L. PRITCHETT

Filed : July 16, 2003

Confirmation No. 8848

For : OBSERVATION OPTICAL DEVICE

REPLY BRIEF UNDER 37 C.F.R. §41.41

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief- Patents
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Examiner's Answer dated August 28, 2006, to the Appeal Brief filed July 24, 2006, Appellants submit the present Reply Brief.

Appellants maintain that each reason set forth in the Appeal Brief filed July 24, 2006 for the patentability of the pending claims is correct and again respectfully request that the decision of the Examiner to reject claims 1-8 be reversed and that the application be returned to the Examining Group for allowance.

REMARKS

It is respectfully submitted that the Appeal Brief filed July 24, 2006, has fully addressed the requirements for patentability of the pending claims. Accordingly, the herein-contained remarks are merely supplemental to the Appeal Brief filed on July 24, 2006, and all previously-proffered arguments in this Brief are incorporated herein. In order to facilitate review of this Reply Brief and for the sake of brevity, the present remarks do not include a discussion of all rejected claims or points raised by the Examiner, and such is not to be considered an acquiescence to the Examiner's rejections or remarks.

Regarding the disputed term "theoretical position," on page 9 of the Examiner's Answer, the Examiner asserted that "the only time in the entire specification theoretical position is mentioned is on page 37, lines 14-18" and "[t]here is no definition of theoretical position as the position of the photographic optical system, on the contrary, the position of the photographic optical system as set forth in the specification is at a different position 'in comparison with a theoretical position.'"

Appellants respectfully traverse the Examiner's assertion. For example, it is noted that page 37 is not the only place in the specification that the theoretical position appears. Specifically, the theoretical position of the cam groove 75 (which determines the position of the photographing optical system 69 along the optical axis), is shown in phantom lines in Fig. 13. It is well settled that the drawings are considered to be part of the specification.

Secondly, Appellants assert that one skilled in the art would understand, at least based on the cam grooves of Fig. 13, that when an object contained in the close-range

view is observed, the photographing optical system is positioned closer to an object side, in relation to a theoretical position of the photographing optical system, and that the definition of the theoretical position thus need not be expressly defined. Specifically, as previously noted by Appellants, the arrangement of the photographing and observation lenses (each of which focus light) are also shown in, e.g., Figs. 1, 3 and 8, and such is described in the specification at, *inter alia*, page 27, line 7 – page 28, line 4. Further, page 29, line 4 – page 30, line 2, describes the helicoid cam grooves of Fig. 9 and how they associate movement between the pair of telescopic optical systems 12R and 12L and the photographing optical system 68, and further describes that the focal length of the photographing optical system 69 is adjusted due to the configuration of the cam grooves 64, 75, it is thus readily apparent to those skilled in the art that the modification of the cam grooves (shown in Fig. 13) would alter the relative position along the optical axis of the photographing lenses.

The Examiner also asserted at Page 9 of the Examiner's Answer that during prosecution the additional limitations regarding the theoretical position cannot provide a basis for support of these limitations within the original presentation of the application. Appellants of course agree, and note that Appellants are not relying on the added "theoretical position" limitations to provide a basis of support. Rather, as discussed *supra*, Appellants assert that the application as filed includes sufficient disclosure to provide such support.

The Examiner further asserted that the informal figures presented in the Amendment of January 20, 2006 "are not part of the original disclosure and cannot therefore overcome the 35 U.S.C. 112 1st paragraph rejection" and that "even if these

figures were to clarify the definition of a theoretical position the figures are not based solely on the original disclosure and the ability of one of ordinary skill in the art to interpret the original disclosure, but include additional knowledge conveyed in the original disclosure.” Appellants again respectfully traverse the Examiner’s assertion. Appellants note, contrary to the Examiner’s assertion, that these informal figures do not include additional knowledge, but rather were provided to further understanding of the Examiner (who is not one skilled in the art) that one skilled in the art would understand the theoretical position as defined in the claims. Specifically, as noted *supra*, it is Appellants’ intention to provide these figures to show those not of skill in the art (e.g., the Examiner) that the modification of the cam grooves (shown in Fig. 13) would alter the relative position along the optical axis of the photographing lenses, as clearly described in the specification (e.g., at page 27, line 7 – page 28, line 4 and at page 29, line 4 – page 30, line 2) to those skilled in the art.

Regarding the Examiner’s rejection of claims 1-8 under 35 U.S.C. § 103(a) as being unpatentable over YAMAZAKI in view of KOBAYASHI, Appellants appreciate the Examiner identifying U.S. Patent Nos. 3,661,064 and 6,603,164, as well as a printout of the online Photonics Dictionary. In this regard, Appellants are well aware that the prior art is replete with devices having reticles; however, Appellants note that they are not claiming to have invented the reticle, but rather are claiming, *inter alia*, “a measured dioptric power difference between a first dioptric power of a combination of an eye of the user and an ocular lens system of said observation optical system, focusing on said reticle, and a second dioptric power of a combination of the eye and said ocular lens system and an objective lens system of said observation optical system, focusing on an

object to be observed, is cancelled (emphasis added)" as recited in claim 1. In this regard, the Examiner has provided absolutely no motivation to combine the reticles of U.S. Patent Nos. 3,661,064 and/or 6,603,164 with the applied YAMAZAKI and KOBAYASHI references to arrive at at least the above-noted limitation of claim 1. Appellants thus respectfully maintain that none of the references of record teach or suggest, either alone or in any proper combination, the non-limiting embodiment of claim 1 (and the claims dependent therefrom).

Further, Appellants note that the Examiner has not provided the relevant page(s) of the discussed Merriam-Webster's (identified on page 10 of the Examiner's Answer), and requests that the Examiner provide such page(s) in the next official communication to Appellants.

CONCLUSION

Appellants again respectfully submit that claims 1-8 are patentable under at least 35 U.S.C. §§ 112 and 103(a) over any proper combination of the teachings of YAMAZAKI and KOBAYASHI. Specifically, claims 1-8 clearly comply with the provisions of 35 U.S.C. § 112, first paragraph, and the applied art of record fails to teach or suggest the unique combination of features recited in Appellants' claims 1-8 for at least the reasons noted *supra*. Accordingly, Appellants respectfully request that the Board reverse the decision of the Examiner to reject claims 1-8 and remand the application to the Examiner for withdrawal of the rejections.

Should the Examiner have any questions or comments regarding this paper, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Masami SHIRAI et al.

William S. Boshnick

Reg. No. 44,550

Will S. Bosh

Bruce H. Bernstein
Reg. No. 29,027

October 4, 2006
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191